

**THIS DISPOSITION
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OF THE T.T.A.B.**

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1491
Alexandria, Virginia 22313-1491**

Lykos

Mailed: April 27, 2006

Opposition No. 91165327

Hawaiian Moon, Inc.

v.

Rodney Doo

Before Quinn, Bucher and Kuhlke, Administrative Trademark
Judges.

By the Board:

Applicant seeks to register the mark HAWAIIAN MOON for
"clothing and sportwear, namely shirts and dresses"
in International Class 25.¹ Opposer has opposed
registration on the grounds that applicant's mark, when used
on the identified goods, so resembles opposer's previously
used mark HAWAIIAN MOON for "clothing, namely shirts, and
dresses and bottoms"² and retail clothing store services as
to be likely to cause confusion, mistake, or to deceive

¹ Application Serial No. 76571974, filed January 27, 2004,
alleging August 28, 2000 as the date of first use anywhere and in
commerce, with a disclaimer of HAWAIIAN.

² Application Serial No. 76602164, filed July 13, 2004, alleging
December 2, 1999 as the date of first use anywhere and in
commerce. Opposer's application has been suspended pending
disposition of applicant's mark.

prospective consumers within the meaning of Section 2(d) of the Trademark Act.³

Applicant, in its answer, denied most of the salient allegations of the notice of opposition, but admitted that its applied-for mark is identical to opposer's pleaded mark.

This case now comes up for consideration of opposer's motion for summary judgment on its claims of likelihood of confusion and priority of use. The motion is fully briefed.⁴

First, we will review the parties' respective arguments. Opposer argues that it has standing to bring the present opposition proceeding because its application has been suspended pending disposition of applicant's applied-for mark. As to its claim of likelihood of confusion, opposer maintains that no genuine issue of material fact exists because applicant has admitted that the parties' marks are identical, and it is undisputed that the

³ To the extent, if any, opposer intended to assert a claim of dilution in the notice of opposition, we find that opposer has failed to properly plead such a claim. See *Toro Co. v. Torohead Inc.*, 61 USPQ2d 1164 (TTAB 2001); and *Polaris Industries Inc. v. DC Comics*, 59 USPQ2d 1798 (TTAB 2000).

⁴ Applicant has move to strike opposer's reply brief as impermissible under the Trademark Rules of Practice as well as to strike opposer's additional evidence submitted concurrently therewith. Contrary to applicant's assertions, the Board does have the discretion to consider reply briefs. See Trademark Rule 2.127(a). Moreover, because the additional evidence submitted by opposer is directed to the statements made by applicant in its responsive brief, applicant's motion to strike is denied. The Board has considered opposer's reply brief and supplemental evidence in its determination.

goods at issue are identical. On the issue of priority, opposer maintains that it purchased HAWAIIAN MOON logo artwork on September 7, 1999, hang tags on October 15, 1999 and woven labels on October 29, 1999, all for the intended purpose of bearing opposer's mark on apparel; that it has used its mark in interstate commerce at least as early as November 1999 when it ran a promotional campaign on a radio station and provided the radio station personnel with matching shirts, all bearing the mark HAWAIIAN MOON on the labels; that applicant, in response to opposer's requests for admissions, admitted that it did not commence interstate use of its HAWAIIAN MOON mark until August 28, 2000; and that as such, opposer has established its claim of prior use.

In support of its motion for summary judgment, opposer has attached the declaration of Mr. Aaron Chan, president of opposer, with the following exhibits attached thereto: copies of the March 16, 2005 and March 7, 2005 Office actions issued by the examining attorney regarding opposer's pending application; opposer's first set of requests for admissions and applicant's responses thereto; a copy of a photograph of radio personnel wearing matching shirts with the term "Aloha" printed on the front from opposer's promotional campaign in November 1999; and invoices showing opposer's purchases of radio advertising spots, logo

artwork, hang tags, and labels in September and October of 1999.⁵

In response to opposer's motion for summary judgment, applicant contends that opposer has failed to submit proper documentary evidence of prior use; that specifically, opposer has not submitted hang tags, labels, or an article of clothing bearing a hang tag or label with opposer's mark; that the photograph of the radio personnel in the matching "Aloha" shirts is undated and shows no labels bearing opposer's HAWAIIAN MOON mark; and that the copies of the invoices referring to the purchase of hang tags, logo artwork and labels contain no pictures of such items.

Applicant has submitted with its responsive brief his own declaration averring that he is the owner of the Yat Loy Company Inc., Ltd., a cutting facility for Hawaiian style garments; that the store was founded in 1904; that he is the owner of a Japanese trademark registration for the mark HAWAIIAN MOON; that in August 2000 he displayed clothing

⁵ The Board also notes that opposer has enclosed portions of the record (i.e. opposer's admission requests and applicant's responses thereto, opposer's interrogatories and respondent's responses thereto, and the Board's final order) from an earlier case involving both parties, Cancellation No. 92042101, *Hawaiian Moon, Inc. v. Rodney Doo*. By way of background, in that case, the Board canceled applicant's Registration No. 2483280 for the mark HAWAIIAN MOON for "clothing and sportswear, namely, shirts, shorts, skirts, dresses, caps, swimwear and sweatshirts" on the ground that applicant fraudulently procured its trademark registration. The Board found that not all of the goods covered by the statement of use were then being sold in interstate commerce.

bearing the HAWAIIAN MOON at a trade show in Las Vegas, Nevada; and that since that time he has continuously sold in interstate commerce clothing bearing the HAWAIIAN MOON mark. Attached to applicant's declaration are various exhibits, including excerpts from an undated book entitled "Master Book of Hawaiian Shirt" and an undated photo of a label bearing the mark HAWAIIAN MOON from the Yat Loy Company appearing therein; a copy of applicant's Japanese trademark registration; and examples of applicant's labels bearing the mark HAWAIIAN MOON. Applicant also submitted the declaration of Mr. James Wray, applicant's attorney, stating that opposer has failed to meet its burden of proof on summary judgment by failing to submit hang tags or labels bearing its mark.

In reply, opposer argues that applicant has failed to submit any evidence of his own use or use by a related company prior to opposer's date of first use of November 1999; that applicant admits, and his evidence shows, that he did not commence use of his mark in interstate commerce until August 2000; and that applicant's evidence of a Japanese registration is irrelevant. With its reply, opposer has submitted a second declaration from Mr. Chan, with new exhibits, including a photograph dated March 16, 2006, of a shirt bearing the mark HAWAIIAN MOON on a label which, according to Mr. Chan, is identical to the label on

the shirts worn by the radio personnel during the November 1999 promotional campaign. Opposer has also submitted the declaration of Mr. Michael Lowe, an account executive with KCCN FM radio station, stating that as part of the opening of opposer's store, he and other radio employees wore HAWAIIAN MOON shirts on November 6, 1999.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S.Ct. 2548 (1986). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. See *Opryland USA, Inc., v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). When the moving party's motion is supported by evidence sufficient to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the burden shifts to the nonmoving

party to demonstrate the existence of specific genuinely-disputed facts that must be resolved at trial. The nonmoving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine issue of material fact for trial.

Based on the submissions of the parties, we find that opposer has met its burden of demonstrating that there are no genuine issues of material fact, and that opposer is entitled to judgment as a matter of law.

A plaintiff moving for summary judgment in its favor on a Section 2(d) claim must establish that there is no genuine dispute that (1) it has standing to maintain the proceeding; (2) it is the prior user of its pleaded mark; and (3) contemporaneous use of the parties' respective marks on their respective goods would be likely to cause confusion, mistake or to deceive consumers. *See Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733 (TTAB 2001).

A. Standing

With regard to whether opposer has standing to maintain this proceeding, we note that applicant has not challenged opposer's standing to oppose the involved application. As discussed in more detail below, we find that the evidence of

opposer's prior use of its HAWAIIAN MOON mark and the fact that applicant's involved mark was cited as a potential bar under Section 2(d) to registration of opposer's mark as set forth in opposer's pending application are sufficient to establish opposer's standing to bring this case. As such, no genuine issue of material fact exists on the issue of standing.

B. Priority

We turn next to the issue of whether there is a genuine issue of material fact regarding opposer's asserted priority of use. To establish priority on a likelihood of confusion claim brought under Trademark Act Section 2(d), a party must prove that, vis-à-vis the other party, it owns "a mark or trade name previously used in the United States ... and not abandoned...." Trademark Act Section 2, 15 U.S.C. Section 1052. A plaintiff may establish its own prior proprietary rights in a mark through actual use or through use analogous to trademark use, such as use in advertising brochures, trade publications, catalogues, newspaper advertisements and Internet websites which creates a public awareness of the designation as a trademark identifying the party as a source. See Trademark Act Sections 2(d) and 45, 15 U.S.C. Section 1052(d) and 1127; *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996), vacating

Pactel Teletrac v. T.A.B. Systems, 32 USPQ2d 1668 (TTAB 1994).

The crux of the parties' dispute on this issue lies in their disagreement regarding the probative value of opposer's evidence of prior use. We find that the declarations of Mr. Aaron Chan relied on by opposer contain unequivocal statements regarding opposer's date of first use in interstate commerce of its HAWAIIAN MOON mark, and are sufficient to establish opposer's date of first use as November 6, 1999. In particular, the first declaration of Mr. Aaron Chan includes the following statements:

3. Since November 6, 1999, opposer has sold clothing with labels bearing the trademark "HAWAIIAN MOON."
4. The clothing that Opposer has been selling under its trademark "HAWAIIAN MOON" includes shirts, skirts and dresses, and other clothing items ("Opposer's Goods").
5. Opposer has operated a retail clothing store service under the service mark "HAWAIIAN MOON" since November 6, 1999.
6. Since November 6, 1999, Opposer has advertised, sold and distributed the Opposer's Goods under its trademark "HAWAIIAN MOON."

Mr. Chan's second declaration, submitted with opposer's reply brief, merely provides supplemental and more detailed information regarding opposer's date of first use of its mark, and is entirely consistent with the statements made in

the first declaration. To illustrate, below are relevant excerpts from the second declaration:

3. Since November 6, 1999, opposer has sold clothing with labels and hang tags bearing the trademark "HAWAIIAN MOON."

4. The clothing that Opposer has been selling under its trademark "HAWAIIAN MOON" includes shirts, skirts and dresses, and other clothing items ("Opposer's Goods").

5. Opposer is and has continuously since November 6, 1999 been advertising, selling, and distributing Opposer's Goods in connection with its trademark "HAWAIIAN MOON."

6. Continuously since November 6, 1999, all of Opposer's Goods sold at opposer's "HAWAIIAN MOON" retail store have had affixed to them labels and hang tags bearing the trademark "HAWAIIAN MOON."

Thus, the declarations of Mr. Chan, coupled with the documentary evidence consisting of the photograph of the label submitted with opposer's reply brief, are sufficient to establish opposer's date of first use as November 6, 1999.

We now turn to applicant's evidence of use. Applicant, in response to opposer's admission requests, has admitted that his earliest date of first use is August 28, 2000 (admission nos. 16 and 17). Applicant has not moved to withdraw or amend his admissions. These admissions alone demonstrate that no genuine issue of material fact exists as to opposer's pleaded claim of priority.

Notwithstanding the above, the admissions are consistent with the statements contained in applicant's own

declaration that applicant did not commence use of its mark until August 28, 2000. This is also the first use date set forth in the involved application. While applicant alludes to prior use of the mark HAWAIIAN MOON by another entity, the Yat Loy Company, and has stated in his declaration that he is the owner of the other company, he has submitted no evidence to establish a relationship between the Yat Loy Company's use of the mark HAWAIIAN MOON and his own use of the HAWAIIAN MOON mark (i.e., an assignment document of the mark to applicant). Moreover, none of the evidence of the Yat Loy Company's use of the mark is dated. In addition, applicant's Japanese registration has no probative value in this proceeding. We therefore find that opposer has established that there is no genuine issue of fact that it is the prior user of its pleaded HAWAIIAN MOON mark.

C. Likelihood of Confusion

Turning to the issue of likelihood of confusion, we are guided by the factors set forth in the case of *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Our determination of likelihood of confusion is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. Our primary reviewing Court has held that only those *du Pont* factors shown to be material or relevant in the particular case and which have evidence

submitted thereon are to be considered. See *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

In this particular case, the two key factors are the degree of similarity of the parties' marks and the degree of similarity of their respective goods and services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). It is clear that there is no genuine issue of material fact that the marks at issue are identical and consist of the following word mark -- HAWAIIAN MOON. Indeed, applicant, in its answer to the opposition, admitted that the parties' marks are identical.

With regard to the similarity of the goods at issue, the goods identified in applicant's involved application, "clothing and sportwear, namely shirts and dresses" are identical to the goods recited in opposer's pending application -- "clothing, namely shirts, and dresses . . .". Indeed, we note that applicant does not dispute in its responsive brief that the parties' respective goods are identical.

As to opposer's retail store services featuring the sale of opposer's clothing, it is well settled that confusion is likely to result from the use of the same or similar mark for goods and for retail store services involving the sale of those goods. See *e.g., In re U.S.*

Shoe Corp., 229 USPQ 707 (TTAB 1985). We therefore find that there is no genuine issue of material fact and that confusion is likely to result as a matter of law.

Based on the foregoing, we find that there is no genuine issue of material fact for trial. Moreover, as a matter of law, our finding that confusion is likely is consistent with the case law holding that in circumstances where the marks are identical and used on identical goods, confusion is not only likely but also inevitable. See *Reflange Inc. v. R-Con Int'l*, 17 USPQ2d 1125 (TTAB 1990).

Accordingly, opposer's motion for summary judgment is granted; the opposition is sustained, and registration of applicant's mark is refused.